

**REMARKS**

Claims 1-7 are pending in this application. Claims 1-4, 6 and 7 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 3,849,960 (hereinafter "Henry"). Claim 5 stands rejected under 35 U.S.C. § 103(a) as allegedly obvious over the knowledge of one of ordinary skill in the art in view of Henry.

**Claim Rejection – 35 USC § 102**

Claims 1-4, 6 and 7 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 3,849,960 (hereinafter "Henry"). The Examiner asserts that "Henry teaches an elongated pre-cast concrete element (10) that has longitudinally extending upper and lower generally parallel surfaces (located at approximately 32 and 36), longitudinally extending convex side surfaces, and an internal reinforcement element (column 4, lines 16-17)." The Examiner concludes that the reinforcement element is inherently located in a passage extending along within the element. Applicant respectfully disagrees.

With respect to claim 1, Applicant respectfully submits that Henry fails to teach a reinforcing bar that, as cited in the instant claims, extends between the end surfaces of an elongated pre-cast concrete element. Instead, Henry provides the non-enabling disclosure that "internal reinforcing structure may also be included" (as the Examiner points out) and focuses on "the principal feature of the wall module 10," described as "stud passages." Column 3, lines 11-12. "Internal reinforcing structure" could conceivably take any of innumerable forms, and Henry fails to teach or suggest the particular reinforcement element presently recited in the claims. Furthermore, while studs are mentioned (see, e.g., column 1, lines 20-24; column 2; lines 18-20), such elements extend vertically (see, e.g., Figures 1 and 5), act as guide elements for the modular construction units of Henry (see, e.g., column 4, lines 3-8), and fail to provide advantages offered by the instant invention such as load-bearing enhancement. See, e.g., Table 3 of the amended sheets. Thus, Henry fails to recite all the elements of instant claim 1 and cannot anticipate it.

With respect to instant claims 2-4 (which depend from claim 1), Henry fails to teach elongated pre-cast concrete elements (of claim 1) that further contain a longitudinal passage extending between the end surfaces (claim 2), a reinforcing bar located in the passage so as to extend between the end surfaces (claim 3), or an elongated pre-cast concrete element wherein the reinforcing bar is embedded within said element (claim 4). Instead, Henry provides pre-fabricated wall modules that mount over studs, preferably made of light weight, weather-resistant plastic. See

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column 4, lines 12-14. As Henry fails to teach each of the foregoing elements of claims 2-4, it cannot anticipate these claims either.

As Henry fails to anticipate claims 1-3, it cannot anticipate claims 6 and 7, which depend from claims 1 and 2 and claim 3, respectively.

Thus, in view of the foregoing, claims 1-4, 6 and 7 cannot be anticipated by Henry. The Applicant respectfully requests reconsideration and withdrawal of this rejection.

### **Claim Rejection – 35 USC § 103**

Claim 5 stands rejected under 35 U.S.C. § 103(a) as allegedly obvious over the knowledge of one of ordinary skill in the art in view of Henry. More specifically, the Examiner asserts that Henry teaches a wall structure and that it would have been obvious to one of ordinary skill in the art to place a layer of mortar or cement between adjacent layers of concrete elements because "concrete/mortar is an extremely well known material that is placed between concrete elements" which "provides an additional bond between the elements."

Claim 5 depends from (presently amended) claim 4, which depends from (presently amended) claim 1. Thus, for claim 5 to be rendered obvious, the combination of Henry and the knowledge of one of ordinary skill in the art would have to suggest the combination of every element of the present claims.

Neither Henry nor the knowledge of those of ordinary skill in the art, alone or in combination, renders obvious claim 5. As argued above, reinforcing elements could take any of myriad forms, none of which is suggested by Henry. Further, neither Henry nor the knowledge common to those of ordinary skill in the art teach or suggest containing a reinforcing bar within a concrete element as presently claimed; nor do they teach any of the advantages taught by the Applicant. For example, the present specification provides copious teaching regarding preferred manifestations of the reinforcing element (see, *inter alia*, page 3, lines 10-17 or page 5, lines 3-17 of amended sheets; Figure 1A). The instant specification further provides the correlation between the diameter of reinforcing bar and the load bearing limit (see Table 3, amended sheets), an exemplary concrete mixture for the invention (see Table 1, amended sheets), and cost break-outs highlighting the cost advantages of the present invention (see, e.g., Table A and page 10). In contrast to the Examiner's contention, none of the above-specified exemplary disclosure is common knowledge to one of ordinary skill in the art or rendered obvious over a reference related to stud-supported modular building elements that lack a

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reinforcing bar extending between the end surfaces of the elements, wherein the reinforcing bar is preferably embedded within said element as found in the present invention.

Moreover, Applicant respectfully submits that the Examiner must provide documentary evidence to support her assertion that one of ordinary skill in the art would utilize mortar or cement between adjacent building layers when constructing a wall according to the invention. More specifically, it is appropriate for the Examiner to "take official notice" of what is common knowledge in the art only when facts beyond the record asserted to be well known are "capable of such instant and unquestionable demonstration as to defy dispute." See *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970); MPEP 2144.03a. Applicant respectfully submits that it is not common knowledge to one of ordinary skill in the art to utilize concrete or mortar in the construction of a structure made from novel, elongated, pre-cast concrete elements of the instant invention, and the Examiner has provided no evidence to the contrary.

Further, for the Examiner to take official notice in the absence of documentary evidence, the technical line of reasoning underlying such decision must be clear and unmistakable. See MPEP 2144.03b. More specifically, "general conclusions concerning what is 'basic knowledge' or 'common sense' to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection." See *In re Lee*, 277 F.3d 338, 1344-1345 (Fed. Cir. 2002); MPEP 2144.03b. The Examiner provides merely that it would have been obvious to "place a layer of mortar or cement between the adjacent layers of concrete elements since concrete/mortar is an extremely well known material placed in between concrete elements," and that doing such "provides an additional bond between the elements, thereby increasing the overall strength of the wall." Innumerable materials, or no materials at all, can be placed between any kind of building elements, thus casting doubt on a general assertion that placing any one material between building elements would be obvious to one of ordinary skill in the art. Thus, Applicant submits that the Examiner's reliance on an official notice is improper and fails to provide the necessary specific factual findings and concrete evidence in the record. Instead, the rejection is based on "general conclusions concerning what is 'basic knowledge'...to one of ordinary skill in the art." Therefore, Applicant respectfully submits that claim 5 cannot be obvious over the knowledge of one of ordinary skill in the art in view of Henry and requests reconsideration and withdrawal of this rejection.

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**CONCLUSION**

Reconsideration of this application is respectfully requested and a favorable determination is earnestly solicited. Further, Applicant submits that the pending claims are in condition for allowance, and issuance of a Notice of Allowance is respectfully requested. The Patent Office is invited to contact the undersigned representative if it is believed that this would be helpful in expediting prosecution of this application.

Respectfully submitted,

**OFFICIAL**

Dated: September 19, 2003

  
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